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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,510	06/07/2000	Pramod B. Mahajan	1121	9021

27310 7590 06/18/2002

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JOHNSTON, IA 50131

EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 06/18/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/589,510	Applicant(s) MAHAJAN, PRAMOD B.	
	Examiner Medina Ibrahim	Art Unit 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2002 and 16 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1638

### **DETAILED ACTION**

The text of these sections of the Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3-9 are pending in this application and are under examination.

Applicants' response filed on 2/19/02 and the Supplemental response of 4/16/02 have been entered. It is noted that page 5 of the response of 2/14/02 is missing. Applicants are required to provide a substitute page in response to this Office action.

#### ***Withdrawn Rejections and Objections***

The objection to the specification, the rejection under 112, 2nd paragraph to claims 3-9 and the art rejection to claims 1, 3-9 have been withdrawn in view of Applicant's amendment to the claims in the responses filed 2/19/02 and 4/16/02. The utility rejection for the entire SEQ ID NO:3 encoding SEQ ID NO:4 has been withdrawn, as the RuvB activity by SEQ ID NO:3 or 4 is an inherent property.

#### ***Claim Rejections - 35 USC § 101 Utility***

Claims 1, 3-9 remain rejected are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. This rejection is repeated for the same reasons as set forth in pages 4-8 of the Office action mailed on 11/20/01. Applicant's responses of 2/19/02 and 4/16/02 have been considered but are not fully persuasive.

Art Unit: 1638

Applicants' argument in pages 7-10 of the response of 4/16/02 regarding the substantial utility (RuvB activity) of SEQ ID NO:3 encoding SEQ ID NO:4 is persuasive. However, Applicants' argument that utility is asserted for a polynucleotides having at least 85% sequence identity to SEQ ID NO:3 and encoding a polypeptide having RuvB activity is not persuasive because neither Applicants' specification nor the prior art teaches or provides guidance for how a RuvB activity can be assayed or tested. No working examples have been disclosed and no RuvB activity have been confirmed for a polynucleotide having less than 100% of SEQ ID NO:3. Therefore, one skilled in the art would not be able to readily use a polynucleotide having less than 100% sequence identity to SEQ ID NO:3. Therefore, the utility rejection is maintained.

***Claim Rejections - 35 USC § 112, 1st paragraph***

Claims 1 and 3-9 remain rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention without undue experimentation. Applicants should note that no working examples have been disclosed for a polynucleotide having less than 100% of SEQ ID NO:3 and still having RuvB activity.

***Remarks***

No claim is allowed.

Art Unit: 1638

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (703) 306-5822. The Examiner can normally be reached Monday -Tuesday from 8:00AM to 4:00PM and Wednesday-Thursday from 9:00AM to 3:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

June 16, 2002  
mai

*Phuong Bui*  
PHUONG T. BUI  
PRIMARY EXAMINER 6/17/02